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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,717	07/13/2001	Anders Onshage	032927-012	9292

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EXAMINER

CHOW, MING

ART UNIT PAPER NUMBER

2645

DATE MAILED: 12/18/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/903,717

Applicant(s)

ONSHAGE ET AL.

Examiner

Ming Chow

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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1. Applicant's AFTER FINAL REQUEST FOR RECONSIDERATION (paper No. 12) is considered and the application is re-entered for prosecution.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 5-16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (US: 6529602), and in view of Harman (US: 5826235).

Regarding claims 1, 5, 8 and 14, Walker et al teach a method and apparatus for recording telephone conversations users. Walker et al also teach on column 6 line 62-67 the audio vault sends a message requesting authorization to the second telecommunication device for the recording. The second telecommunication device responds authorization to the first telecommunication device by using the touch tone keys or with a voice command.

Walker et al teach on Fig. 1C part 1 (reads on "telecommunication device") and vault (recoding means which sends a message requesting authorization for the recording"). Walker et

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al is silent on “party 1 telecommunication device and the vault are collocated”. However, Harman teaches on column 7 line 48-67 the recording system collocates with the UIS (claimed “telecommunication device”) by an in-house telephone link. Therefore, Harman teaches a telecommunication device collocates with a recording means by a telephone link. The combination of the UIS and the recording system is the claimed “first telecommunication device”. Also, “Official Notice” is taken that it is old and well known to one skilled in the art that a telecommunication device (example, a telephone set) equipped with a recording device function. Combining with Walker et al that a recording means can send a message requesting authorization for recording, the first device (a telephone set equipped with a recording means) is the claimed “first telecommunication device” that sends a message for request of authorization.

Regarding “the first and second telecommunications devices each comprise a speaker and a microphone”, Walker teach on column 10 line 36-38 a touch tone telephone.

It would have been obvious to one skilled at the time the invention was made to modify Walker et al to have the “sending from said first telecommunication device.....a message requesting authorization for the recording” as taught by Harman such that the modified system of Walker et al would be able to support a first telecommunication device equipped with a recording system so that the message for authorization of recording can be sent from the first telecommunication device to the system users.

Regarding claim 2, it is inherent that when the authorization responded by the second telecommunication device is negative the recording is prohibited.

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Regarding claim 3, Walker et al teach on column 6 line 63-65 the requesting message is a voice message.

Regarding claims 6, 10 and 15, the system of Walker et al must advise the user of the first telecommunication device whether the authorization request is granted or not.

Regarding claim 7, regarding "said telephone conversation.....additional telecommunication device". Walker et al teach on column 5 line 23-25 embodiment for recording conference call.

Regarding claim 9, Walker et al teach on column 6 line 54-57, voice recognition processor.

Regarding claims 11 and 16, Walker et al teach on column 6 line 44-67 the authorization from the second party is received (reads on the claimed "stored") by the audio vault (the claimed "device").

Regarding claim 12, Walker et al teach on column 12 line 50-54 the system could use triangulating cellular phone signals. It is obvious that the telephone devices taught by Walker et al include cellular telephones (the claimed "mobile telephone").

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Regarding 13, Walker et al teach on column 6 line 57-67, the audio vault (the claimed “telecommunication device”) automatically responds to the authorization request by sending a query to the second party.

3. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (US: 6529602), and in view of Harman, Kim (US: 6278884) and Lee (US: 6526287).

All rejections as stated in claim 1 above apply.

Regarding the recording being performed under control of said first telecommunication device, Walker et al teach on column 7 line 1-2 the audio vault (the claimed “first telecommunication device” controls the recording).

Walker et al failed to teach “performing said recording, by circuit integrated in the first telecommunications device”, Kim teaches on items 11, 44, 54, 22 Fig. 2 integrated circuitry for performing the recording.

Walker et al failed to teach “performing said recording, by an accessory attached to the first telecommunication device”, Lee teaches on Fig. 4, column 1 line 64-67 a cellular phone with an attached accessory (“MP3 player” of Lee) to record sound from a mike and speaker mixer via a call processing part.

It would have been obvious to one skilled at the time the invention was made to modify Walker et al, Harman to have “performing said recording, by circuit integrated in the first telecommunications device or by an accessory attached to the first telecommunication device” as taught by Kim and Lee such that the modified system of Walker et al, Harman would be able to support the recording either by integrated circuit or by an accessory to the system users.

*Response to Arguments*

4. Applicant's arguments filed on 10/20/03 have been fully considered.

Applicant's AFTER FINAL REQUEST FOR RECONSIDERATION (paper No. 12) is considered and the application is re-entered for prosecution. A new prior art (Harman) is recited for rejections as stated in claim 1.

*Conclusion*

5. The prior art made of record and not replied upon is considered pertinent to applicant's disclosure.

- Cho (US: 5544231) teaches conversation recording/playback method in a key phone system.

6. Any inquiry concerning this communication or earlier communication from the examiner should be directed to the examiner Ming Chow whose telephone number is (703) 305-4817. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this

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application or proceeding should be directed to the Customer Service whose telephone number is (703) 306-0377. Any inquiry of a general nature or relating to the status of this application or proceeding should be mailed to:

**Commissioner of Patents and Trademarks**

**Washington, D.C. 20231**

**Or faxed to TC2600's Customer Service FAX Number 703-872-9314.**

Patent Examiner

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Ming Chow



FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

